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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/822,115 01/17/92 SAADATMANESH

EXAMINER

ASCHENBRENNER, P

ART UNIT	PAPER NUMBER
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3309
DATE MAILED:

09/29/92

DRESSLER, GOLDSMITH, SHORE,
SUTKER & MILNAMOW, LTD
TWO PRUDENTIAL PLAZA
180 NORTH SETSON AVE., STE 4700
CHICAGO, IL 60601

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 9/10/92 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-30 are pending in the application.
Of the above, claims 6, 13, 14, 28 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-5, 7-12, 15-27, 29, 30 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

Art Unit 3309

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to adequately describe how to make and use the invention. As the wave guide emits a circular pattern of radiation, it is not seen that the rotation of the fiber about its axis contributes to the therapeutic effects of the device. The disclosure fails to address this issue. Further, the techniques of distance measuring by infrared or sonar determination and computer controlled movement of the distal end of the fiber optic have not been adequately disclosed.

Claims 8, 9, 16, 17 and 26 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the ^{interaction} ~~???~~ of the surgical instrument with a computer control system, infrared and sonar control system and the fiber bundle must be shown or the feature canceled from the claim. No new matter should be entered.

The requirement of an election of species as set forth in the previous office action is extended to include the species using a mirror at the distal end (claim 6) and the species comprising a fiber bundle with beveled distal ends (claim 28). These species were inadvertently overlooked as they have not been illustrated in the drawings. Since applicant has selected the claims directed to the embodiment of the invention as illustrated in figure 1, claims 6 and 28 along with non-elected claims 13 and 14 are withdrawn from consideration.

Claims 1-5, 7-12, 18-22, 25-26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims are considered indefinite in that it is not clear if the radiation beam is to be directed coincidental with the axis of the wave guide or along another path parallel to the same and the method claims fail to definitely establish either the controlling steps desired or their sequence.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 10, 11, 18-20 are rejected under 35 U.S.C.

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§ 102(b) as being clearly anticipated by Hessel et al.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 1-5, 7-12, 18-27, 29 and 30 are rejected under 35 U.S.C. § 103 as being unpatentable over Hessel et al in view of Hayes et al. These claims are met by the Hessel device with the exception of using drive means to angularly displace the distal end of the fiber and rotate the same, a technique shown to be recognized in the art by Hayes (note figures 13G-13J) and considered an obvious modification to Hessel to obtain enhances emission control. The selection of the fiber optic material, type and wave length of radiation are considered an obvious matter of experiment within the skill of the art. Using infrared or sonar means for distance determination and computer controls for directing the fiber optic and controlling beam intensity is also

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considered within the skill of the art.

Nishioka, Reick, Sinofsky and Buys et al show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (703) 308-0858.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Peter Aschenbrenner/dh
September 28, 1992



PETER A. ASCHENBRENNER
PRIMARY EXAMINER
GROUP 330